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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,047	08/28/2001	Umair A. Khan	CLICP008	7341
28875	7590	11/02/2006	EXAMINER	
Zilka-Kotab, PC P.O. BOX 721120 SAN JOSE, CA 95172-1120			HARBECK, TIMOTHY M	
			ART UNIT	PAPER NUMBER

3692

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/942,047

Applicant(s)

KHAN ET AL.

Examiner

Timothy M. Harbeck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 8-14, 33-39 and 41 are rejected under 35 U.S.C. 102(e) as being anticipated by Adam et al (hereinafter Adam, US 2002/0069164 A1).

**Re Claim 1:** Adam discloses a method for carrying out a computer-implemented transaction comprising:

- Storing in memory a transaction pattern reflecting a transaction (Page 1 paragraph 0001-0003)
- Executing the transaction pattern to carry out the transaction (Page 1, paragraph 0002, last sentence)

**Re Claim 2:** Adam discloses the claimed method supra and further discloses wherein the transaction pattern includes a record of:

- Information submitted by a user (i.e. previous bill of materials)
- User actions taken by the user (paragraph 0028, "identification information provided by the user.")

- System actions taken by a system in response to the information and the user actions in order to generate results (paragraph 0028 “server compares the user provided information with to the pre-stored information...” ) and
- The results that are sent to the user (paragraph 0003 “If at least one bill of materials matches the received user criteria for the bill of material, the pre-stored bill of material information is downloaded for communication to the user).

**Re Claim 3:** Adam discloses the claimed method supra and further discloses wherein the transaction pattern includes a record of actions taken by the system which enable access of the user to data (paragraph 0028 “server then receives identification information from the user and retrieves a selected project from a database resident on server.)

**Re Claim 4:** Adam discloses the claimed method supra and further discloses wherein the transaction pattern includes the storage of records relating to a user interface presented to a user (paragraph 0042, Fig 15; screen shot is a saved interface previously presented to a user).

**Re Claim 5:** Adam discloses the claimed method supra and further discloses wherein the transaction pattern includes the storage of records relating to the submission of information by a user (paragraph 0002; “retrieve a previously generated bill of material”).

**Re Claim 6:** Adam discloses the claimed method supra and further discloses wherein the transaction pattern includes the storage of parameters required to complete the transaction (paragraph 0028 "The pre-stored information includes various types of bill of material related information.")

**Re Claim 8:** Adam discloses the claimed method supra and further discloses wherein the transaction pattern includes the storage of information returned to a user by a system (paragraph 0003; pre-stored bill of materials is returned to the user by the system, where it can be further edited or simply re-submitted)

**Re Claim 9:** Adam discloses the claimed method supra and further discloses wherein the transaction pattern includes the storage of information selected by the user (paragraph 0039; "the system brings the user back to the product selection page preconfigured according to the product that the user wants to edit.")

**Re Claim 10:** Adam discloses the claimed method supra and further discloses wherein the execution of the transaction pattern includes retrieval of the transaction pattern by at least one of an automated agent and a programmable agent (paragraph 0028 "server" is an automated agent).

**Re Claim 11:** Adam discloses the claimed method supra and further discloses wherein the execution of the transaction pattern includes submission of required parameters during the transaction (paragraph 0028 "The pre-stored information includes various types of bill of material related information.")

**Re Claim 12:** Adam discloses the claimed method supra and further discloses wherein the execution of the transaction pattern involves automatic navigation during

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the transaction (paragraph 0028; the presentment of a previously submitted bill of materials is an automatic navigation of the previous steps the user had to perform in order to generate said bill of materials).

**Re Claim 13:** Adam discloses the claimed method supra and further discloses wherein the execution of the transaction pattern includes retrieval of content (paragraph 0001-0003)

**Re Claim 14:** Adam discloses the claimed method supra and further discloses wherein the execution of the transaction includes relaying content to a user (paragraph 0001-0003)

**Re Claim 33:** Adams discloses a method for carrying out a computer implemented transaction comprising:

- Recording information submitted by a user as part of a transaction (previously submitted bill of materials assumes information has been recorded 0003)
- Recording user actions taken by a user as part of the transaction (records original submission of bill of materials for later use; paragraph 0003)
- Recording system actions taken by the system in response to the information and the user actions in order to generate results as part of the transaction;
- Recording the results that are sent to a user as part of the transaction (0042; bill of material is the results that are sent to the user)

- Generating a transaction pattern based on the recorded information (transaction pattern is used to regenerate the previously submitted bill of materials automatically as opposed to manually repeating all tasks; paragraph 0001);
- Storing the transaction pattern in memory (0003; saving user information) and;
- Executing the transaction pattern to automatically carry out the transaction upon receiving a user request for the transaction (0003)

**Re Claims 34-39:** Previously rejected claims 3, 8-10, 12 and 14 have previously shown that Adams has anticipated these limitations. For the sake of brevity please refer to those respective claims for citation of the prior art.

**Re Claim 41:** Adams discloses a method for carrying out a computer-implemented electronic commerce (e-commerce) transaction comprising:

- Storing in memory a transaction pattern reflecting a transaction wherein the transaction pattern includes (paragraph 0001-0003)
  - Creation and actions associated with forms presented in a web-interface with which a user submits information (paragraph 0020 “web based;” also see Figs 4-16 for web based screen shots and paragraphs 0028-0043 for creation of bill of material forms)
  - Information submitted by a user, in forms presented in an ecommerce flow (paragraphs 0001 “ecommerce;” see paragraphs

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0028-0043 for form creation; specifically paragraph 0039 "Bill of Material Page."

- An internal process whereby the submitted information is sent to servers and databases of an ecommerce site (0026)
- Navigation of the user within the e-commerce process (see paragraphs 0028-0043, navigate to create and edit bill of materials)
- Results returned by the e-commerce site once the submitted information has been processed (paragraph 0042 "recalled bill of material page.")
- Executing the transaction pattern to carry out the transaction (0002 "fulfillment.")

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-21, 23-32 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adam.

**Re Claim 15:** Adam discloses the claimed method supra but does not explicitly disclose wherein the execution of the transaction includes recognizing the state of a remote transaction. However it was well known in the art at the time of invention for



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computer related applications to come in a variety of different "states" or formats. It therefore would have been obvious to anyone of ordinary skill at the time of invention to allow the method of Adam to determine and recognize a variety of common application states so that the appropriate content can be pulled and organized from a variety of sources. If the method of Adam did not perform this step than only some formats would be recognized and important data may not be forwarded on to the user.

**Re Claims 16-21 and 23-30:** Further computer program product claims would have been obvious in order to implement the previously rejected method claims 1-6 and 8-15 respectively and are therefore rejected using the same art and rationale.

**Re Claim 31:** Further system claim would have been obvious in order to perform the previously rejected method claim 1 above and is therefore rejected using the same art and rationale.

**Re Claim 32:** Adam discloses the claimed method supra and further discloses wherein the remote application is an electronic commerce application (paragraph 0001)

**Re Claim 40:** Adam discloses the claimed method supra but does not explicitly disclose wherein the execution of the transaction includes recognizing the state of a remote transaction. However it was well known in the art at the time of invention for computer related applications to come in a variety of different "states" or formats. It therefore would have been obvious to anyone of ordinary skill at the time of invention to allow the method of Adam to determine and recognize a variety of common application states so that the appropriate content can be pulled and organized from a variety of

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sources. If the method of Adam did not perform this step than only some formats would be recognized and important data may not be forwarded on to the user.

Claim 7 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adam in view of Arnold et al (hereinafter Arnold, US PAT 6,016,504).

**Re Claim 7:** Adam discloses the claimed method supra but does not explicitly disclose wherein the storage of transaction pattern includes the storage of records of the navigation of a user during the transaction. Arnold discloses a method and system for tracking the purchase of a product wherein user navigation patterns are tracked so that websites can receive referral bonuses when there is a direct link between a purchase at one site as a result of a referral to another (Column 3, lines 23-37). It would have been obvious to a person of ordinary skill in the art at the time of invention to include these steps to the disclosure of Adam so that users can see the particular vendors that provided each of the particular materials on the bill. Therefore if a one particular item on the bill was insufficient, the user will know the supplier from which it originated.

**Re Claim 42:** Adams and Arnold have been shown to explicitly or implicitly disclose each limitation of claim 42 in the previously rejected claims 1-15 and 33-41 and therefore claim 42 is rejected using the same rationale as those previous claims. For the sake of brevity the examiner notes the following.

- (a)-(d) and (g)-(h) of claim 42 are the same as respective parts (a) – (g) in claim 33 and therefore the same rationale applies

- for (e) and (f) see rejection of claim 34
- for the sub categories of (h)
  - for (i) see rejection of claim 4
  - for (ii) see rejection of claim 2
  - for (iii) see rejection of claim 6
  - for (iv) see rejection of claim 7
  - for (v) see rejection of claim 8
  - for (vi) see rejection of claim 9
- for the sub categories of (i)
  - for (i) see rejection of claim 10
  - for (ii) see rejection of claim 15
  - for (iii) see rejection of claim 11
  - for (iv) see rejection of claim 12
  - for (v) see rejection of claim 13
  - for (vi) see rejection of claim 14

### ***Response to Arguments***

Applicant's arguments filed 09/14/2006 have been fully considered but they are not persuasive.

With regards to claim 1, the applicant argues that nowhere in the Adam reference is it indicated that the bill of materials is executable. Rather the user is merely allowed to recall the bill of material for editing and resubmission. The examiner believes that the

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"resubmission," of the bill of materials for "fulfillment" is synonymous with being "executable." Respectfully, the applicant has not explained why he believes submitting a bill of materials for fulfillment diverges from executing a transaction, only the assertion that it is different. Furthermore, the examiner maintains that a saved bill of materials is in fact a saved version of a particular pattern of individual transactions that, collectively, make up a unique document. As disclosed in Adam this saves users time in that they do not have to reenter information, in the same pattern, into the system, which is both inconvenient and increases the chance of errors (0002). The rejection is therefore maintained.

With regard to claims 2 and 3 the applicant argues that the cited portion of Adam does not disclose a record of user actions taken by the user. The examiner maintains thought that the submission of identification information, is in fact a user action and therefore a record of information submitted by the user is essentially the same as a record of actions taken. The action in this case is the submission of information. Any other "actions," would need to be explicitly claimed. The applicant continues that the identification information provided by the user, in the Adam reference, is not recorded at all, but rather is merely used to retrieve other data and discarded. In response, the examiner believes that inherently this information must be stored in order to relate the entered information to the appropriate record of the bill of materials. If this information were discarded every time it was entered it would not be possible to retrieve the appropriate document in the future, which is the central tenet of the Adam invention.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action for claims 7 and 42.

With regards to claim 10-14, the applicant claims that there is an inherent defect in the logic of the rejections because a transaction pattern was claimed. Upon further review the examiner believes that this was a simple typo error and that the rejections were provided in light of the claimed limitations. As discussed in claim 1, the examiner maintains that a saved bill of materials is in fact a saved version of a particular pattern of individual transactions that collectively make up a unique document. For instance in claim 13, the applicant asserts that Adam merely indicates users can recall a saved bill of materials. However claim 13 only calls for the retrieval of content when executing a transaction pattern, which is precisely what Adam does (0001-0003). Furthermore the examiner believes that the applicant is wrong in asserting that the execution aspect is lacking, based on the fact that the bill of materials is submitted for fulfillment.

Regarding claim 12, the examiner maintains that the presentment of a previous bill (transaction pattern; see claim 1) is in fact an automatic navigation of the previous steps. The examiner interprets automatic navigation to mean, arriving at the same prior result without outside interference, which is precisely what the Adam reference achieves. Repetition of individual steps, previously performed, would have to be positively claimed to be considered.

With regards to claim 33, With regard to claims 2 and 3 the applicant argues that the cited portion of Adam does not disclose a record of user actions taken by the user. The examiner maintains thought that the submission of identification information, is in

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fact a user action and therefore a record of information submitted by the user is essentially the same as a record of actions taken. The action in this case is the submission of information. Any other "actions," would need to be explicitly claimed.

With regards to claim 41, the examiner refers the applicant back to the arguments presented for claim 1.

With regards to claims 15, 30, 40 and 42, the applicant states that Adam does not teach or suggest recognizing the state of a remote application, and that all of Adam's executables appear to be local. First it is noted that the applicant's submits that Adams contains "executables," which appears contrary to previous arguments. Second Adams does explicitly disclose remote applications (see paragraph 0025) and therefore the rejections are proper.

Arguments with respect to claims 16-29 and 31 refer back to similar arguments and therefore the same rationale provided by the Examiner for maintaining the previous rejection further applies to these claims.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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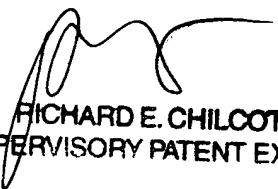
TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Harbeck whose telephone number is 571-272-8123. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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RICHARD E. CHILCOT, JR.  
SUPERVISORY PATENT EXAMINER